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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,909	05/09/2001	Karim Kaddeche	998002 PA6	3960

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EXAMINER
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JANVIER, JEAN D

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/851,909

Applicant(s)

KADDDECHE ET AL

9

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/12/2004 has been entered.

**DETAILED ACTION**

***Specification***

The title of the invention, under 37 CFR 1.72, should be descriptive, brief and technically accurate.

**Status of the claims**

Claims 1-13 have been canceled and claims 14-26 have been added. Hence, claims 14-26 are currently pending in the Instant Application.

***Claim Objections***

Claims 14, 19 and 25-26 (including its dependent claims) are objected to because of the following informalities:

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Claims 14 and 19 recite “generating an identifier to describe the Internet client for said server /client session”. Here, the generated identifier can be interpreted as a dynamic IP address (not a static IP address), which is different for every Internet session and unique for each session while the client remains the same, as understood in the art. Further, a dynamic IP address cannot identify a client with great accuracy since only the area code related to the client and used, among other things, to generate the dynamic IP address can be extracted from the IP address (this is a rough geographic estimate based on zip codes covered by the area code).

Concerning claims 25-26, “...have at least one of expiration dates and limits on number of allowable re-use” should apparently be --...have at least one of expiration dates **or** limits on number of allowable re-use--.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Indeed, it appears that the specification does not support a **cached standing bid or impression having an expiration date or limits on number of allowable re-use**.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanson et al. (hereinafter Hanson), US Patent 5,974,398A.

As per claim 14, Hanson discloses an interactive bidding system (sealed, competitive or absentee bidding) for allowing advertisers or impression providers to bid for the right to display their advertising messages to qualified users contingent upon a correlation between the users' profile and the advertisers' criteria **and the highest bid**, wherein a user using a client 160 (wireless terminal) connected to the Internet 130 of fig. 1 makes a request from server 660 (ISP) for information or service. Subsequent to this request, the server 660 accesses a user profile database (102) (110) (700) for the user's profile or characteristics (demographics including location) as well as the user's specified interests, an advertiser's database or advertiser specifications buffer (706) for at least two different advertisers' specifications associated with two different advertisers and compares the characteristics of the user from the user profile database with the characteristics from each respective advertiser. Following this profile matching, the advertiser providing the highest or revised bid value is selected by the user and an

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advertising message related to the selected advertiser (bid winner) is transmitted to the user, for display, by the server 660 and the user receives a reward or credit, as promised, for viewing the selected advertising messages based on the amount of bid wherein the received credit or reward helps pay for the user's online service charge (See abstract; figs 1-3 and 6-15; col. 1:38 to col. 2:10; col. 3: 5-12; col. 4: 54-60; col. 12: 5 to col. 14: 40; col. 11: 17-24; See claims 1 and 7 of the current reference).

In addition, in an alternative embodiment, Hanson discloses an automatic absentee bidding among the advertisers, as shown in figs 14-15, wherein an advertiser's maximum and minimum bid values for an absentee bidding, along with the advertiser's criteria, is recorded. Here, the advertiser can be absent from the network and need not participate directly in the bidding system when the user comes online. To this end, the server 660 provides an automatic absentee bidding, having a maximum and minimum bid, on behalf of the advertisers when a user, having a profile matching the advertiser's bid criteria, comes online. The absentee bidding can operate simultaneously with the competitive bidding method conducted by other advertisers or bidders. When a user visits the system on the Internet and makes a request for a service or information, the server 660 (identifying the user) accesses a user profile database to retrieve the user's characteristics, accesses at least two respective advertisers' specified user's criteria related to two respective advertisers (sub plurality of advertisers), compares the user's retrieved characteristics to the at least two respective advertisers' specified user's criteria and selects a first and second advertiser (from the sub plurality) with specifications matching the user's characteristics. If an advertiser from the sub plurality (subset) of advertisers has a maximum bid (value) less than a highest minimum bid value, as defined or computed by the system, then the

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advertiser's bid is ignored. Furthermore, if an advertiser from the sub plurality of advertisers has a maximum bid (value) greater than a second highest maximum bid value of the sub plurality of advertisers, then the server 660 retains this advertiser's bid (through this absentee bidding process, the highest bidder is selected as the winner). **Thereafter, transmitting automatically (without the user's intervention) from the server 660 to the Internet client or user the winning bid value along with the advertiser's name (or a short message describing the business the advertiser is in),** receiving by the server 660 from the user a signal indicating the user's acceptance of the offer and retrieving from the server 660 the advertiser's **complete** message related to the winning bid and displaying the message on the user's computer screen (here only the winning bid is displayed on the user's computer-figs 14-15; col. 13: 39 to col. 14: 21).

Finally, Hanson does indeed support the steps of retrieving, during a user's online visit, from a customer profile database 102 of fig. 1 the user's profile information, forwarding the user's profile information **(including address, interests, etc.)** to the bidding advertisers (advertising offer manager), comparing the user's profile information to the advertisers' criteria (testing stage), displaying the advertisers' bid offers to the user's computer screen based on this comparison, selecting by the user a bid offer and retrieving and outputting on the user's computer screen the advertising message related to the selected bid offer. Here, the user's profile information is provided to the advertisers to prepare their bid offers does not necessarily contain the user's permanent identifier (like a password, which remains at the user's computer and may not travel across the wire for security purpose). Further the profile database 102 contains, as disclosed by Hanson, data such as demographic information about the user (age, gender, marital

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status, residence, etc.) as well as the user's psychographic profile. The user's identity is revealed to an advertiser or bid winner only at the completion of a successful transaction, that is after the bidding stage is finished, wherein the user has read an advertising message related to the advertiser or bid winner and if the advertiser has made such a request. This is true in the competitive bidding or absentee bidding. **However, it is herein understood, from a technical point of view, that when the server forwards the user's profile to the advertisers or bidders, an identifier such as a number or a code or a filename, associated with the user's profile information, uniquely identifying the user to the system will be transmitted as well. And upon submitting a bid to the system based on the user's received profile information, the identifier is sent back to the system where it is used to help identify the user not only for billing the advertiser and credit the user's account for viewing the advertisement, but also for revealing, if so requested, the identity of the user to the advertiser or bidder following a successful display (fig. 3; col. 4: 14-24; col. 4: 54-61; col. 6: 52 to col. 7: 53).**

As per claims 15-18, 20-22 and 24-26, Hanson discloses an interactive bidding system (sealed, competitive or absentee bidding) for allowing advertisers or impression providers to bid for the right to display their advertising messages to qualified users contingent upon a correlation between the users' profile and the advertisers' criteria and the highest bid, wherein a user using a client 160 (wireless terminal) connected to the Internet 130 of fig. 1 makes a request from server 660 (ISP) for information or service. Subsequent to this request, the server 660 accesses a user profile database (102) (110) (700) for the user's profile or characteristics (demographics including location) as well as the user's specified interests, an advertiser's database or advertiser



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specifications buffer (706) for at least two different advertisers' specifications associated with two different advertisers and compares the characteristics of the user from the user profile database with the characteristics from each respective advertiser. Following this profile matching, the advertiser providing the highest or revised bid value is selected by the user and an advertising message related to the selected advertiser (bid winner) is transmitted to the user, for display, by the server 660 (Internet access provider) and the user receives a reward or credit, as promised, for viewing the selected advertising messages based on the amount of bid wherein the received credit or reward helps pay for the user's online service charge. Furthermore, an interesting advertiser using workstation 120 can communicate to the online service platform 100 a set of defined user attributes, characteristics and weights applied to such attributes, wherein these characteristics, attributes or variables and weights are used by the advertiser to develop appropriate bids for the right to display his advertising messages to a particular user having a particular profile or characteristics and attributes (income, residence, gender, etc.) in accordance with a weight or scale given to specific subset or specific parameters or attributes from the user's profile, such as ages of viewing or participating users, matching the advertiser's predefined attributes from the advertiser's specifications (filtering a subset of the profile information based on predetermined criteria) (See abstract; figs 1-3 and 6-15; col. 1:38 to col. 2: 10; col. 3: 5-12; col. 3: 50-56; col. 4: 54-60; col. 5: 64 to col. 6: 5; col. 9: 18-23; col. 10: 32-39; col. 12: 5 to col. 14: 40; See claims 1 and 7 of the current reference).

In addition, the user's activity is monitored, tracked and maintained in the active user and advertiser buffer 732 (col. 9: 45-51). Information regarding the number of times a particular advertisement is viewed by a user and at what times and whether the advertisement was

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previously viewed is stored in advertiser offers database 106 (col. 5: 12-16). Further, usage session history database 118 stores a user's prior online session usage, wherein the online service provider uses such information to track a particular session (col. 4: 61 to col. 5: 2). Moreover, it is herein to be understood that the user's activity collected from the tracking or monitoring process is used to update the user's profile, thereby allowing the online service to determine whether an advertisement has already been seen by the user and, in the affirmative, either exclude it from further consideration or offer it at a reduced rate to the user on behalf of the advertiser, who received the user's name or identity, depending on the advertiser's wishes (col. 11: 17-24; fig. 13).

Finally, the client can further influence the decision making process of the system by selecting a winning bid among one or more qualified bids submitted by the advertisers based upon some factors (the Internet client further specifies one or more criteria for an advertiser to present an ad-See abstract).

As per claims 19 and 23, Hanson discloses an interactive bidding system (sealed, competitive or absentee bidding) for allowing advertisers or impression providers to bid for the right to display their advertising messages to qualified users contingent upon a correlation between the users' profile and the advertisers' criteria and the highest bid, wherein a user using a client 160 (wireless terminal) connected to the Internet 130 of fig. 1 makes a request from server 660 (ISP) for information or service. Subsequent to this request, the server 660 accesses a user profile database (102) (110) (700) for the user's profile or characteristics (demographics including location) as well as the user's specified interests, an advertiser's database or advertiser

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specifications buffer (706) for at least two different advertisers' specifications associated with two different advertisers and compares the characteristics of the user from the user profile database with the characteristics from each respective advertiser. Following this profile matching, the advertiser providing the highest or revised bid value is selected by the user and an advertising message related to the selected advertiser (bid winner) is transmitted to the user, for display, by the server 660 and the user receives a reward or credit, as promised, for viewing the selected advertising messages based on the amount of bid wherein the received credit or reward helps pay for the user's online service charge. Furthermore, an interesting advertiser using workstation 120 can communicate to the online service platform 100 a set of defined user attributes, characteristics and weights applied to such attributes, wherein these characteristics, attributes or variables and weights are used by the advertiser to develop appropriate bids for the right to display his advertising messages to a particular user having a particular profile or characteristics and attributes (income, residence, gender, etc.) in accordance with a weight or scale given to specific subset or specific parameters or attributes from the user's profile, such as ages of viewing or participating users, matching the advertiser's predefined attributes from the advertiser's specifications (filtering a subset of the profile information based on predetermined criteria) (See abstract; figs 1-3 and 6-15; col. 1:38 to col. 2: 10; col. 3: 5-12; col. 3: 50-56; col. 4: 54-60; col. 5: 64 to col. 6: 5; col. 9: 18-23; col. 10: 32-39; col. 12: 5 to col. 14: 40; See claims 1 and 7 of the current reference).

It is herein understood that when certain attributes from the user's profile match an advertiser's defined variables or characteristics and the bid value offered is acceptable, the advertiser receives the identify of the targeted user and earns the right to display at least one

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advertising message to the user, who may choose to view the advertising message immediately or in the future (reserving the right to present an ad to a qualified user) (col. 8: 39-41; col. 10: 40-52; col. 11: 17-24; col. 13: 1-3; figs. 11 and 13).

In addition, in an alternative embodiment, Hanson discloses an automatic absentee bidding among the advertisers, as shown in figs 14-15, wherein an advertiser's maximum and minimum bid values for an absentee bidding, along with the advertiser's criteria, is recorded. Here, the advertiser can be absent from the network and need not participate directly in the bidding system when the user comes online. To this end, the server 660 provides an automatic absentee bidding, having a maximum and minimum bid, on behalf of the advertisers when a user, having a profile matching the advertiser's bid criteria, comes online. The absentee bidding can operate simultaneously with the competitive bidding method conducted by other advertisers or bidders. When a user visits the system on the Internet and makes a request for a service or information, the server 660 (identifying the user) accesses a user profile database to retrieve the user's characteristics, accesses at least two respective advertisers' specified user's criteria related to two respective advertisers (sub plurality of advertisers), compares the user's retrieved characteristics to the at least two respective advertisers' specified user's criteria and selects a first and second advertiser (from the sub plurality) with specifications matching the user's characteristics. If an advertiser from the sub plurality (subset) of advertisers has a maximum bid (value) less than a highest minimum bid value, as defined or computed by the system, then the advertiser's bid is ignored. Furthermore, if an advertiser from the sub plurality of advertisers has a maximum bid (value) greater than a second highest maximum bid value of the sub plurality of advertisers, then the server 660 retains this advertiser's bid (through this absentee bidding

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process, the highest bidder is selected as the winner). Thereafter, transmitting from the server 660 to the Internet client or user the winning bid value along with the advertiser's name (or a short message describing the business the advertiser is in), receiving by the server 660 from the user a signal indicating the user's acceptance of the offer and retrieving from the server 660 the advertiser's message related to the winning bid and displaying the message on the user's computer screen (here only the winning bid is displayed on the user's computer-figs 14-15; col. 13: 39 to col. 14: 21).

In addition, Hanson does indeed supports retrieving, during a user's online visit, from a customer profile database 102 of fig. 1 the user's profile information, forwarding the user's profile information to the bidding advertisers (advertising offer manager), comparing the user's profile information to the advertisers' criteria (testing stage), displaying the advertisers' bid offers to the user's computer screen based on this comparison, selecting by the user a bid offer and retrieving and outputting on the user's computer screen the advertising message related to the selected bid offer. Here, the user's profile information provided to the advertisers to prepare their bid offers does not necessarily contain the user's permanent identifier (like a password, which remains at the user's computer and may not travel across the wire for security purpose). Further the profile database 102 contains, as disclosed by Hanson, data such as demographic information about the user (age, gender, marital status, residence, etc.) as well as the user's psychographic profile. The user's identity is revealed to an advertiser or bid winner only at the completion of a successful transaction, that is after the bidding stage is finished, wherein the user has read an advertising message related to the advertiser or bid winner and if the advertiser has made such a request. This is true in the competitive bidding or absentee bidding. **However, it is**

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herein understood, from a technical point of view, that when the server forwards the user's profile to the advertisers or bidders, an identifier such as a number or a code or a filename, associated with the user's profile information, uniquely identifying the user to the system will be transmitted as well. And upon submitting a bid to the system based on the user's received profile information, the identifier is sent back to the system where it is used to help identify the user not only for billing the advertiser and credit the user's account for viewing the advertisement, but also for revealing, if so requested, the identity of the user to the advertiser or bidder following a successful display.

Finally, it is implicitly supported in the Hanson's system that each impression or advertisement has an associated date stamp (advertisements are typically run for a certain period of time until expired). Hanson also teaches that the user can be exposed to the same advertisement in more than one occasion, if the advertiser so desires, and in this case the advertiser will pay a reduced fee for displaying the repeated advertisement to the user (limiting the number of times an impression can be viewed by a user-col. 11: 21-32)

(fig. 3; col. 4: 14-24; col. 4: 54-61; col. 6: 52 to col. 7: 53).

### **Response To Applicant's Arguments**

In general, Applicant's arguments are related to the newly amended claims and are fully addressed in the above Office Action. Furthermore, Applicant argues that the bidding system as disclosed in the claimed invention is transparent to the user (i.e. the bidding system is silent or passive). However, the latter features has not been claimed thus far and the Examiner does not

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read limitations from the specification into the claimed invention (See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5,794,210 to Goldhaber discloses, among other things, a system for paying a customer for viewing an ad on the Internet wherein the customer is specifically targeted using profile information provided by the customer and wherein advertisers can bid for the right to display their advertising messages to the customer.

**WO 98/34189 A1** to Roth discloses a system for displaying an ad to a customer on the Internet wherein the customer is specifically targeted using profile information provided by the customer and wherein advertisers can bid for the right to display their advertising messages to the customer.

US Patent 6,324,519 to Elderly discloses an advertising auction system.

US Patent 5, 724,521 to Dedrick discloses a system for displaying an ad to a customer on the Internet wherein the customer is specifically targeted using profile information provided by

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the customer and wherein advertisers pay for the right to display their advertising messages to the customer based on a best-fit profile matching.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

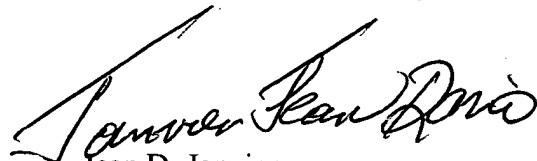
After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ  
11/14/04



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Art Unit 3622